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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,730	01/26/2004	Norbert Miller	SWR0124US	1107
23413 7590 02/23/2009 CANTOR COLBURN, LLP 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER JOHNS, CHRISTOPHER C				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 02/23/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary

Application No.

10/765,730

Applicant(s)

MILLER ET AL.

Examiner

Christopher C. Johns

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Claims 1, 2, 5, and 6 are pending.
2. This Office action is given Paper No. 20090207 for reference purposes only.
3. All references to the capitalized version of "Applicant" refer specifically to the Applicant or Applicants of record in the instant application. Any references to lowercase versions of "applicant" or "applicants" refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.

Continued Examination Under 37 C.F.R. §1.114

4. A request for continued examination under 37 C.F.R. § 1.114, including the fee set forth in 37 C.F.R. §1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 30 December 2008 has been entered.

Specification

5. The amendment filed 30 December 2008 is objected to under 35 U.S.C. §132(a) because it introduces new matter into the disclosure. 35 U.S.C. §132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "direct visual authentication of the document" (as in claim 6).
6. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 6 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.
9. Claim 6 notes that the "verification method is performed via direct visual authentication of the document". This subject matter is not contained in the specification: page 3 notes that "the document can be recorded as an image and the image can be transmitted to an operator", but does not note "[directly]" enabling visual authentication (i.e.: presenting the document *itself* to the operator, rather than an image).

Claim Rejections - 35 USC § 112 2nd Paragraph

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Independent claim 1 recites "at least one of accepting the document when the document passes the visual verification and refusing acceptance when the document does not the visual verification".

13. Firstly, the claim is rejected for being unclear, by not having a verb following "when the document does not" and preceding "the visual verification". This is believed to be "pass".

14. Secondly, the claim notes that a "visual verification" is provided to an operator, and then has a decision as to whether it "passes the visual verification"; however, there is no step performed in the visual verification that would determine whether a document passes or does not pass. A person having ordinary skill in the art would not understand whether:

- a. this visual verification is presented to the operator in order for the operator to "accept" or "reject" the document, or
- b. if the visual verification is merely shown to the operator (and the "accept"/"reject" decision is made by a machine (such as the "central computer unit 4", as mentioned on lines 9-12 of page 5 of the specification)).

15. As these situations are clearly different and mutually exclusive, the claim is rendered indefinite. Solely for the purpose of applying prior art, and despite the deficiency in the claim, the Examiner has interpreted this in the latter sense.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent Application Publication 2001/0006556 ("Graves").

18. feeding document to verification unit (figure 1, reference number 10) by means of input unit (figure 1, reference number 18), wherein verification unit is provided for authenticating the document (Abstract - "system for evaluating currency bills with currency evaluation machines...");

19. authenticating document, wherein authentication document is performed with a combination of at least two different verification methods (figure 1, reference numbers 20, 28; figure 2a, reference numbers 38, 40);

20. comparing the at least two verification methods with verification specifications (§10 - "a system memory stores first and second types of master characteristic information corresponding to genuine currency bills of assorted denominations and/or series");

21. determining a probability of authenticity of the document (Abstract - "evaluated bills are identified as either no call bills, suspect documents, or genuine bills");
22. releasing the document for further processing, comprising accepting document as positively authenticated when the probability meets predetermined criteria (§14 - "if a positive determination is reached in the comparison test, the bill is authenticated as genuine");
23. providing visual verification when the probability does not meet the predetermined criteria and the document is negatively authenticated, the visual verification including recording document as an image (§35 - "The microprocessor 12 stores each element of data from the optical sensor 20 in a range of memory locations in a random access memory ("RAM") 26, forming a set of image data that corresponds to the object scanned") and presenting the image to an operator (§82 - "The CPU 72 is also linked to an output unit which may be programmed to provide a display of...any other recorded identifying characteristic of the no call, suspect, or genuine bills."), and at least one of accepting the document when the document passes the visual verification (the document is accepted into the system, as well as from step to step; i.e.: figures 6a to 6b - when a document is accepted into the second set of verification steps) and refusing acceptance when the document does not [pass] the visual verification (§38 - "machine is stopped to allow removal....[or] delivered to a separate output receptacle").
24. As per claim 2, Graves discloses as above, and further discloses:
25. two verification methods are selected from the group comprising size verification, magnetic verification (§5 - "currency discrimination is based on the comparison of sensed optical

or magnetic characteristics"), image verification, infrared verification, UV verification (§6 - "UV or visible light..."), and visual verification (§6 - "visible light reflectance");

26. As per claim 5, Graves discloses as above, and further discloses:
27. visual verification method is performed only on documents of a desired value (only currency is scanned using the system in Graves - see Abstract as well as ¶2 - as such, documents that are not currency (and have no value) will not be scanned or verified).
28. As per claim 6, Graves discloses as above, and further discloses:
29. visual verification method is performed via a direct visual authentication of the document (figure 6a, reference 98 - "scanned intensity"; figure 4a, reference s1, s2, s3, s63, s64).

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Graves in view of Applicant's Admitted Prior Art.
32. As per claims 1, 2, 5, and 6, it is the Examiner's primary position that the claims are

anticipated because of the above inherent features (i.e. showing image data to the operator)¹.

However, if an administrative body finds this feature to be non-inherent, then it is now Admitted Prior Art that showing image data of unauthenticated documents was old and well-known in the art because it allows the operator to either report the document (since there is an image, it can be copied or printed, and reported to the proper authorities), override the determination (in case there is a clear error in processing), or at least to better understand why the document was rejected (in case the document is dirty, damaged, or misaligned). This creates a more powerful system where operators may view exactly what the problem is with a document, in order to ascertain why it would not be authenticated by the system, and/or take further corrective action.

33. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to show operators images of unauthenticated documents, as this would allow them to better understand why a particular document was deemed as counterfeit. A person having ordinary skill in the art would see this as advantageous because it allows for a more reliable system, one that allows operators to better determine why documents are rejected.

Claim Interpretation

34. In accordance with MPEP §2111.01, the Examiner has interpreted the meaning of claim limitations in accordance with their "plain meaning", unless such terms have been defined explicitly in the specification.

35. Claim 1 recites "providing visual verification when the probability does not meet the predetermined criteria and the document is negatively authenticated..." The last two steps of the

¹ MPEP §2112.III authorizes a rejection under 35 USC §102 as well as 35 USC §103, when the "the composition of

method in claim 1 are contingent upon the document failing the predetermined criteria. If the method is run where all documents pass the "predetermined criteria", then the last two steps will not run. Therefore, these steps are seen as optional language. Optional or conditional elements do not narrow claims because they can always be omitted. See *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted"), and MPEP §2106 II C, which states "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (emphasis in original text).

Response to Arguments

36. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

37. As per Applicants' arguments that the "Grave operator makes no further decision regarding acceptance or refusal", the Examiner has established above that this limitation is not present in the claims. It is not explicitly stated that the operator is the one who "accepts" or "refuses" the document, merely that it is accepted or refused based on whether it "passes the visual verification" (who performs this verification is not explicitly stated).

38. As per Applicants' arguments concerning the Official Notices, Applicants' attempt at traversing the Official Notice findings as stated in the previous Office Action (Mail Date 3

the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference". The

October 2008, Paragraph No. 9-10p) is inadequate. Adequate traversal is a two step process.

First, applicant(s) must state their traversal on the record. Second, and in accordance with 37

C.F.R. §1.111(b), which requires applicants to specifically point out the supposed errors in the

Office Action, Applicants must state why the Official Notice statements are not to be considered common knowledge or well known in the art.

39. In this application, while Applicants have clearly met step (1), Applicants have failed step (2) since they have failed to argue why the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicants' traversal is inadequate, the Official Notice is taken to be admitted as prior art. See MPEP §2144.03.

Conclusion

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462.

The Examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

41. If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621